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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,449	05/08/2002	Marcello Allegretti	0471-0260P	7039

2292 7590 07/15/2003

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EXAMINER
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OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/15/2003

*10*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/830,449

Applicant(s)

ALLEGRETTI ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**The Status of Claims:**

Claims 1-8 are pending.

Claim 1 has been rejected.

Claims 2-8 have been objected.

**DETAILED ACTION**

1. The Preliminary Amendment dated 12/13/2002 (Paper No. 7) has been received and placed of a record in the file.

**Priority**

2. The continuing data of the 371 of PCT/EP99/07887 on 10/18/1999 has been entered in the specification.

**Drawings**

3. The specification does not specify the need for drawings.

**Specification**

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The disclosure is objected to because of the following informalities:

- on the first page of the specification, the page number is absent.  
Appropriate correction is required.
- on the top of every page, the WO application # and PCT/EP99/07887 are written. However, this is improper.  
Appropriate correction is required.
- on the top of page 11, the term "Druckexempler" is stated, whereas at the bottom of pages 11-12, the term "AMENDED SHEET" is stated. However, they are improper. Appropriate correction is required.
- in line 13 on page 1, the colon is used after the term "wherein". However, the use of the colon is improper and the examiner recommends that it should be removed.
- in line 18 on page 8, the phrase "3.45 g of (4) were" is recited; the verb "were" should be changed to "was." Appropriate correction is required.

### ***Claim Objections***

Claims 1, 4, and 7 are objected to because of the following informalities:

- the phrase “ subsequent reaction ” is recited in claim 4. However, an article “ the ” should be inserted immediately preceding the term “said subsequent.” Appropriate correction is required.
- the colon is used after the term “ wherein ” in line 11 of claims 1 and 7. However, the use of the colon is improper and the examiner recommends that it should be removed.

### ***Claim Rejections - 35 USC § 112***

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “ a) transformation of compounds of formula(II) into compounds of formula (III)” and “ c) transformation of (III c) into (I)” are recited. However, the claim does not describe how formula(II) can be turned into compounds of formula (III) or how formula(IIIc) can be turned into compounds of formula (I). Therefore, appropriate correction is required.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Coffen et al (U.S. 5,061,629) teaches a preparation of (2R)-2hydroxy arylalkanoic acid esters and (2s)-2-hydroxy arylalkanoic acids by the Pseudomonas lipase-catalyzed selective hydrolysis of racemic (2RS)-2-hydroxy arylalkanoic acid esters in an aqueous medium at a pH of from 5 to 9.

Schloemer (U.S. 4,605,758) teaches a preparation of active alpha-arylalkanoic acids or esters by contacting an aryl magnesium Grignard reagent with an optically active aryl alpha substituted alkyl ketone, which ketalized and rearranged to the desired optically active alpha-arylalkanoic acid or the corresponding ester.

Chiu et al (U.S. 4,910,337) teaches a preparation of alpha-arylalkanoic acids by reacting an alkylaromatic compound with a metallation reagent solution comprising the reaction of alkyllithium or aryllithium and potassium tert-alkoxide in a trialkylamine solvent.

Szebeni et al (GB 1586798) teaches the preparation of a substituted phenyl and naphthyl-alkanoic acids by oxidizing an alkene derivative in the presence of chromic acid at a temperature of from 0 to 70<sup>0</sup> C.

Boots Pure Drug Com Limited (GB 971700) teaches a phenylalkane derivative ,such as 4-n-propylphenylacetic acid by reacting acetyl chloride with a phenyl compound in the presence of Willgerodt and subsequently the resultant product has been hydrolyzed to produce the desired product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*W. J. [Signature]*  
7/14/03